

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MARIO TENUTA, and GEORGE LAZAROVITS

Appeal No. 2006-0250
Application No. 10/017,328

ON BRIEF

MAILED

APR 28 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before ADAMS, MILLS and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 2 and 5, which are all the claims pending in the application.

Claim 2 is illustrative of the subject matter on appeal and is reproduced below:

2. A method of controlling soilborne pathogens in a soil having an organic carbon content less than 1.7% by weight, comprising the step of generating ammonia in said soil, said step of generating ammonia comprising adding a nitrogen containing material and a pH raising agent to said soil to raise soil pH above 8.5 to thereby generate said ammonia to control said soilborne pathogens.

The references relied upon by the examiner are:

Schisler et al. (Schisler)	5,783,411	Jul. 21, 1998
Cooley	6,300,282	Oct. 09,2001

Blodgett et al. (Blodgett), "Relative Effects of Calcium and Acidity of the Soil on the Occurrence of Potato Scab," American Potato Journal, Vo. XII, No. 10, pp. 265-274 (1935)

Menzies, "Potato Scab Control With Calcium Compounds," Phytopathology, Vol. 40, p. 968 (1950)

GROUND OF REJECTION

Claims 2 and 5 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over the combination of Blodgett, Cooley and Schisler, with or without Menzies.

We affirm.

CLAIM GROUPING

Appellants do not separately group or argue their claims. Accordingly, claims 2 and 5 stand or fall together. Since all claims stand or fall together, we limit our discussion to representative independent claim 2. Claim 5 will stand or fall together with claim 2. In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

DISCUSSION

According to the examiner (Answer, page 4), Blodgett disclose that when potatoes are grown in sandy loam soil, the amount and severity of potato scab decreased as pH is increased from 7.2 to 9.2. According to the examiner

(Answer, page 5), Schisler teach that sandy clay loam field soil useful for growing potatoes has an organic matter content of 1.3%. In addition, the examiner finds (Answer, page 4), Blodgett disclose “when a soil heavily infected with potato scab is limed (Ca(OH)_2) to raise the pH to 8.5, 47% of potatoes were clean, and when limed to pH 9.0, 91% of the potatoes were clean....” While Blodgett discusses the effect of soil pH on potato scab, Blodgett does not teach the addition of nitrogen to the soil.

The examiner relies on Colley to make up for the deficiency in Blodgett. According to the examiner (Answer, page 5), Cooley teaches that, among other nutrients, “[p]otatoes require significant amounts of nitrogen...” which can be applied to the solid in granular or liquid form. In this regard, the examiner finds (id.), Cooley teach the addition of nitrogen to soil for growing potatoes.

Based on this evidence the examiner concludes (Answer, page 6), that a person of ordinary skill in the art at the time the invention was made would have recognized that when growing potatoes in sandy loam soil as suggested by Blodgett the organic carbon content of the soil will be 1.3% as taught by Schisler. In addition, a person of ordinary skill in the art would have found it prima facie obvious to apply lime to the soil to raise the pH to 9.0 and thereby achieve 91% clean (scab-free) potatoes. Further, since Cooley teach that potatoes require a significant amount of nitrogen, a person of ordinary skill in the art at the time the invention was made would have found it prima facie obvious to add nitrogen to the soil.

In response, appellants argue (Brief, bridging paragraph, pages 3-4), while Schisler teach “a sandy clay loam soil which has an organic matter content of 1.3[%],” this teaching cannot be applied to Blodgett which does not address the organic matter content of the soil, because “[s]andy loam soils can have a carbon content greater than 1.7%.” In response, the examiner finds (Answer, page 7), appellants fail to provide an evidentiary basis to support their assertion that the sandy loam soil of Blodgett will have an organic carbon content that is greater than 1.7%. In this regard, we remind appellants that attorney argument cannot take the place of evidence lacking in the record. Meitzner v. Mindick, 549 F.2d 775, 782, 193 USPQ 17, 22 (CCPA 1977). Accordingly, we are not persuaded by appellants’ argument.

Appellants also assert (Brief, page 4), while “Cooley does teach the application of nitrogen to a soil,” the reference does not “suggest that the application of nitrogen, in combination with other ingredients would lead to a method for controlling soilborne pathogens by generating ammonia in the soil and which ammonia is effective to control the soilborne pathogens.” In response, the examiner finds (Answer, bridging paragraph, pages 7-8), “it would have been obvious to add nitrogen as suggested by Cooley when potatoes are grown in the limed soil of Blodgett et al for the same reason nitrogen is added to any other soil for growing potatoes, i.e. to provide the nitrogen needed by potatoes to increase yield, which is sufficient motivation for adding nitrogen to limed soil when growing potatoes.”

We agree.

As set forth in WMS Gaming Inc. v. International Game Technology,
184 F. 3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999):

When an obviousness determination relies on the combination of two or more references, there must be some suggestion or motivation to combine the references. See In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The suggestion to combine may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved. See id. at 1357, 47 USPQ2d at 1458. "When determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) quoting Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)).

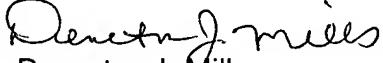
On this record, the examiner has established that when growing potatoes, a person of ordinary skill in the art would increase the pH of the soil to above 8.5 as taught by Blodgett, in addition to adding a nitrogen containing material to the soil as taught by Cooley. As we understand it, appellants' argument appears to be that they have discovered that the addition of nitrogen to a soil having a pH above 8.5 results in the generation of ammonia that is effective in controlling soilborne pathogens. However, as the examiner explains (Answer, page 9), "[p]otato scab is a soilborne pathogen, and supplying nitrogen as suggested by Cooley to potatoes grown at pH 9.0 as disclosed by Blodgett et al will inevitably result in control of potato scab." Accordingly, we find no error in the rejection of record. As set forth in In re Woodruff, 919 F.2d 1575, 1578 16 USPQ2d 1934, 1936 (Fed. Cir. 1990), "[i]t is a general rule that merely discovering and claiming a new benefit of an old process cannot render the process again patentable."

For the foregoing reasons we affirm the rejection of claim 2 under 35 U.S.C. § 103 (a) as being unpatentable over the combination of Blodgett, Cooley and Schisler. As discussed supra claim 5 falls together with claim 2.

Having sustained the rejection on the combination of Blodgett, Cooley and Schisler, we do not address the teachings of Menzies relied upon by the examiner in the alternative.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


Donald E. Adams)
Administrative Patent Judge)
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Demetra J. Mills) BOARD OF PATENT
Administrative Patent Judge)
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Lora M. Green) APPEALS AND
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